

Remarks:

Claims 1-16 and 21 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,233,641, issued to Maeda in view of U.S. Pub. No. 2003/0002476 to Chung et al. Claims 1, 9 and 21 are amended. No new matter has been added. Support for the amended language is provided in the specification and the drawings.

The Examiner contends that it would have been obvious to one of ordinary skill in the art to combine Maeda with Chung in the direction of the claimed invention. This rejection is respectfully traversed.

Maeda is directed to a method of generating an “alert signal” that is audible to a user of a cellular phone, when a connection is successfully established between the cellular phone and another phone. The alert signal disclosed in Maeda is not a “ring back tone” in the same context as that recited in the present claims. That is, a ring back tone as claimed is generated in response to a call set up request submitted by a calling phone, such that the ring back tone is generated while the calling party is waiting for the connection to be established. In contrast, the “alert signal” of Maeda is generated only after a successful connection is established (see col. 4 lines 1-7, discussing “ring back tone” which is distinguishable from “alert tone” on col. 4 line 31 to which the Examiner refers). Furthermore, in col. 4, lines 43-50, Maeda particularly suggest that the alert tone is generated by a “base station.”

In contrast, the invention, as recited in claim 1, is directed to a scenario where a terminal receiving a call (i.e., the first terminal) communicates over a VOIP network, and the terminal initiating the call (i.e., the second terminal) communicates over PSTN, wherein the VOIP and PSTN networks are connected by a trunk gateway, such that upon receiving the call, the first terminal independently generates a ring back tone data (i.e., “without any help from a PSTN switchboard or access gateway”, see paragraph [0052] of the specification) and sends the ring back tone data to the second terminal in a response message such that the second terminal

receives the response message and generates a ring back tone according to the ring back tone data included by the first terminal into the response message.

MPEP §2143 provides:

“To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.”

Respectfully, Maeda fails to teach, suggest or disclose a method to generate a ring back tone as recited in amended claim 1. Particularly, Maeda fails to teach or suggest that the first and the second terminals communicate over two different communication protocols (i.e., VOIP and PSTN) connected by a gateway. Furthermore, Maeda expressly teaches away from the method recited in claim 1 by suggesting that the ring back tone is generated by and transmitted from a *base station* (see col. 4, lines 45-50). In contrast, claim 1 as amended recites that the ring back tone is generated by the *first terminal* independently (i.e., a terminal communicating over an internet protocol, which is receiving a call). Since Maeda directly teaches away from the claimed invention, a person of ordinary skill would not have been motivated to modify Maeda in the direction of the claimed invention or to combine it with another reference.

The Applicant has reviewed Chung and it is respectfully submitted that Chung fails to cure the deficiencies of Maeda. Particularly, paragraph [0028] of Chung suggest a “ring signal” (i.e., the data ring back tone) is generated by PSTN 114 and sent to the calling party. In contrast, claim 1 recites that the ring back tone is independently generated by the VOIP terminal (i.e., by the first terminal without any help from a PSTN switchboard or access gateway, see paragraph [0052] of the specification). As such, Chung also teaches away from the method recited in claim 1. Therefore, it would be unreasonable for the Examiner to suggest the two cited references may be combined to teach the claimed invention, where both of the cited references teach away from the claimed invention.

While the suggestion to modify this reference may come from the knowledge and common sense of a person of ordinary skill in the art, the fact that such knowledge may have been within the province of the ordinary artisan does not in and of itself make it so, absent clear and convincing evidence of such knowledge. C.R. Bard, Inc. v. M3 Systems, Inc., 157 F.3d 1340, 1352, 48 U.S.P.Q.2d 1225, 1232 (Fed. Cir. 1998).

Here, the modification proposed by the Examiner is not based on any clear and convincing evidence of a reason, suggestion, or motivation in the prior art that would have led one of ordinary skill in the art to combine the references. Rather, the reason, suggestion and motivation for the combination of references proposed by the Examiner simply is impermissible hindsight reconstruction given the benefit of Appellant's disclosure.

The Federal Circuit has consistently held that hindsight reconstruction does not constitute a prima facie case of obviousness under 35 U.S.C. § 103. In re Geiger, 2 USPQ2d 1276 (Fed. Cir. 1987). Unfortunately, the Examiner rather than pointing to what the prior art discloses and teaches as to making the suggested modification relies on assumptions and statements without any support in the record. As such, the Examiner's statements regarding obviousness and motivation to modify are but shortcuts to a conclusion of obviousness devoid of the required analytical approach based on what is actually disclosed in the prior art.

Reliance on impermissible hindsight to avoid express limitations in the claims and setting forth unsupported hypothetical teachings to recreate the Applicant's claimed invention cannot establish a prima facie case of obviousness. Since obviousness may not be established by hindsight reconstruction, Applicant invites the Examiner to point out the alleged motivation to combine with specificity,<sup>1</sup> or alternatively provide a reference or affidavit in support thereof,

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<sup>1</sup> ACS Hospital Systems, Inc. v. Montefiore Hospital, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984).

pursuant to MPEP §2144.03.<sup>2</sup>

Since no reasonable justification is provided in the Office Action as to how such modification is possible and obviousness may not be established based on hindsight and conjecture, it is respectfully requested that the 103 grounds of rejection be withdrawn.

For the above reasons, Maeda neither alone nor in combination with Chung teaches or suggests the invention as recited in claim 1. Therefore, it is respectfully submitted that claim 1 is in condition for allowance. Claims 2-8 depend from claim 1 and should be in condition for allowance by the virtue of their dependence on an allowable base claim. Amended claims 9 and 21 substantially incorporate the elements of claim 1; therefore, claims 9, 17 and 21 and claims 10-16 depending from claim 9 should also be in condition for allowance.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope of any claim, unless Applicants have expressly argued herein that such amendment was made to distinguish over a particular reference or combination of references.

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<sup>2</sup> "The rationale supporting an obviousness rejection may be based on common knowledge in the art or "well-known" prior art . . . If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position. When a rejection is based on facts within the personal knowledge of the examiner . . . the facts must be supported, when called for by the applicant, by an affidavit from the examiner."

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California, telephone number (310) 789 2100 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

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